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08/243,526 05/16/94 KONO

35M1/1227

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EXAMINER
S. ATSO3200N LUONG, V

ART UNIT	PAPER NUMBER
3502	34

DATE MAILED:

12/27/94

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 5/16/94 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- ☐ Notice of References Cited by Examiner, PTO-892.
- ☐ Notice of Draftsman's Patent Drawing Review, PTO-948.
- ☒ Notice of Art Cited by Applicant, PTO-1449.
- ☐ Notice of Informal Patent Application, PTO-152.
- ☐ Information on How to Effect Drawing Changes, PTO-1474.
- ☐

Part II SUMMARY OF ACTION

1. ☒ Claims 6-8, 11-16, 18, 20-27 are pending in the application.
Of the above, claims 6-8 are withdrawn from consideration.

2. ☒ Claims 1-5, 9, 10, 17, 19 have been cancelled.

3. ☐ Claims are allowed.

4. ☒ Claims 11-16, 18, 20-27 are rejected.

5. ☐ Claims are objected to.

6. ☒ Claims 6-8, 11-16, 18, 20-27 are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☒ The proposed drawing correction, filed 7/18/1991, has been ☒ approved; ☐ disapproved (see explanation).

12. ☒ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☒ been filed in parent application, serial no. 07/485,659; filed on 2/27/1990.

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

Serial Number: 08/243,526

-2-

Art Unit: 3502

1. Acknowledgment is made of applicant's claim for priority under 35 U.S.C. § 119. The certified copy has been filed in parent application, Serial No. 07/485,659, filed on February 27, 1990.
2. The restriction requirement and the election of Group I in the parent application are carried over to the instant File Wrapper Continuation. See 1046 O.G. 2.
3. Claims 6-8 are withdrawn from further consideration by the examiner, 37 C.F.R. § 1.142(b) as being drawn to a nonelected invention. Election was made without traverse in Paper No. 8.
4. The numbering of claims is not accordance with 37 C.F.R. § 1.126. The original numbering of the claims must be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When claims are added, except when presented in accordance with 37 C.F.R. § 1.121(b), they must be renumbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 19-26 have been renumbered as claims 20-27, respectively.

Note that claims 17 and 19 have been cancelled by the Amendment after Final filed on October 6, 1992 (Paper No. 18). Paper No. 18 has been entered as seen in the Examiner's Answer of

Art Unit: 3502

January 13, 1993. Therefore, new claims 19-26 should be renumbered as 20-27.

5. The interlineations or cancellations made in the specification or amendments to the claims could lead to confusion and mistake during the examination, issue and printing processes. Accordingly, all of the pending claims are required to be rewritten. See 37 C.F.R. § 1.125 and M.P.E.P. § 608.01(q).

6. Claims 11-16, 18, and 20-27 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The terms such as "engageable" and "movable" in claims 11, 14, 16 and 18 are vague and indefinite in the sense that things which may be done are not required to be done, e.g., the engageable surface is engageable, but not required structurally, to be engaged with a clutch disc. See "discardable" and "crimpable" in Mathis v. Hydro Air Industries, 1 USPQ2d 1513, 1527 (D.C. Calif. 1986); "removable" and "removably connected" in In re Burke Inc., 22 USPQ2d 1368, 1372 (D.C. C. Calif. 1992) and "comparable" in Ex parte Anderson, 21 USPQ2d 1241, 1249 (Bd. Pat. App. & Inter. 1992).

The words of degree such as "loosely fit" in claim 24 are vague and indefinite since the specification fails to provide a

Art Unit: 3502

standard for measuring said degree. Ex parte Oetiker, 23 USPQ2d 1651, 1656 (Bd. Pat. App. & Inter. 1992) and cases cited therein.

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 14-16 and 18, as best understood, are rejected under 35 U.S.C. § 103 as being unpatentable over Numata (Japanese Patent Publication No. 57-058542).

The rejections of the Board of Appeal in the Board decision of January 5, 1994 are incorporated herein by reference.

9. Claims 14-16 and 18, as best understood, are rejected under 35 U.S.C. § 103 as being unpatentable over Numata (Japanese Patent Publication No. 57-058542) in view of applicant's prior art admissions set forth on pages 1 and 2 of applicant's specification.

The rejections of the Board of Appeal in the Board decision of January 5, 1994 are incorporated herein by reference.

10. Claims 11-13 and 20-27 would be allowable if rewritten or amended to overcome the rejection under 35 U.S.C. § 112.

11. As allowable subject matter has been indicated, applicant's response must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 C.F.R. § 1.111(b) and section 707.07(a) of the M.P.E.P.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Luong whose telephone number is (703) 308-2168.

Serial Number: 08/243,526

-5-

Art Unit: 3502

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-2168.

Luong

December 27, 1994



VINH T. LUONG
PRIMARY EXAMINER
ART UNIT 352